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K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER YOO, JASSON H	
			ART UNIT 3714	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary	Application No. 10/056,550	Applicant(s) MICHAELSON, RICHARD E.	
	Examiner Jasson H. Yoo	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-44, 46-53, 55-66 is/are pending in the application.
- 4a) Of the above claim(s) 48-50 and 57-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-44, 46, 47, 51-53, 55, 56 and 60-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/7/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/4/09 has been entered.

Claim Objections

Claims 47 and 56 are objected to because of the following informalities: Claim 47, which depends on claim 42 incorporate steps (a) receiving a pause input during the game session; and (b) stopping the deducting step at least temporarily in response to the pause input. However, claim 42, incorporates limitations (a) and (b). Therefore, Claim 47 incorporates multiple limitation "(a)" and limitation "(b)" by dependency. Clarification should be made to differentiate the limitations. Claim 56 is objected for similar reason.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 42-44, 46-47, 60-61 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Comiskey, 499 F.3d 1365, 1376 (Fed. Cir. 2007) (request for rehearing *en banc* pending). The claims are directed to process of playing a game. The claims incorporate the limitations of: receiving a wager, indicating a balance, activating a game, receiving play inputs, providing an outcome, determining an event, continuing game the game session, providing a payout. However, the claim limitations do not specify that the process is tied to a particular machine nor is it inherent that the claimed process is tied to a particular machine. The method of: receiving a wager, indicating a balance, activating a game, receiving play inputs, providing an outcome, determining an event, continuing game the game session, providing a payout, can be performed without a machine.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 42-44, 46-47, 51-53, 55-56, 60-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 42-44, 46-47, 51-53, 55-56, 60-63, incorporate the claim limitation of “for each one of the time intervals, deducting one of the fees from the balance, **the deduction being independent of the play inputs and the outcomes.**” Applicant’s specification fails to disclose that the deductions are independent of the player inputs and the outcomes. Applicant’s specification, explicitly discloses that player input is required (at step 146 in Fig. 4a) for the game session to be active (Applicant’s specification paragraphs 57-58 of US 2003/0144053). If the player does not provide an input the game session is paused (step 159 in Fig. 4a and paragraph 55). Thus an input is required to let the gaming machine know that the game play is not at the idle state. Therefore, the deduction is dependent of the play inputs.

In addition, Applicant also claims that “for each one of the provided outcomes which corresponds to one of the awards, adding the value of the award to the balance, the added value extends the activation period of the game session”. After the award value (winning outcome) is added to the balance, the added value extends the activation period. The added value extends the activation period by deducting at least part of credits of added value/balance [Claim 42 and 51, limitations (a) and (d) (3)].

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Thus, the deduction is dependent on the game outcome, since the winning outcome (award value) is used to fund the balance.

Claims 42-44, 46-47, 51-53, 55-56, 60-63, incorporate the claim limitation of, “for each one of the provided outcomes which corresponds to one of the awards, adding the value of any award to the balance, **the added value extending the activation period of the game session.**” Similarly, claims 64-66 incorporate the claim limitation of “determine an extension time period based on each one of the provided awards; extend the activation time by each one of the extension time periods”. Applicant’s specification fails to disclose that the added value extends the activation period of the game session. Applicant’s specification indicates that the fee may be based on time of play rather than being assessed based on a game event (step 128 in Fig. 4a, and paragraph 47 of US 2003/0144053). Applicant’s specification also indicates that the value payout is added to the value total (or the “balance”, step 170 in Fig. 4b, paragraph 62 of US 2003/0144053). However, there is no description that this added value is used to extend the activation period of the game session. Furthermore, there is no description that the method of extending the activation period occurs automatically (as required in claims 61 and 63).

Claims 42-44, 46-47, 51-53, 55-56, 60-63, incorporate the claim limitation of, “**determining which of a plurality of events occurs first**, the events including: a termination input received from the player; and the balance falling below a minimum

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level required for playing the game". Applicant's specification fails to disclose that the gaming machine determines which event occurs first. It is not clear, why the gaming machine would determine which event occurs first. It appears that the gaming machine determines the occurrence of any termination event, either an input from player or a balance below a minimum, regardless of which event occurs first.

Claims 60-63, incorporate the claim limitation of, "in response **to each one of the play inputs**: display a game play; and **provide an award as a result of a winning event**". Applicant's specification fails to disclose that in response to each one of the play inputs, an award is provided. In other words, Applicant's specification fails to disclose that each game is a guaranteed win. For example, Fig. 5E of Applicant's specification indicates the award could be 0 credits.

Claim Rejections - 35 USC § 112

Claims 46 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 46 and 55 are recites the limitation "the at least one payout". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-44, 46-47, 51-53, 55-56, 60, 62, 64-66 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walker et al. (US 6,077,163).

Claim 42. Walker discloses a method and a gaming system for playing on the gaming system using flat rates for a period of time. Walker discloses wagering fees associated to the time interval the player selects (722 in Fig. 2B). The player can select the same game with the same game parameters using the same wager fee (col. 7:39-54). Thus, these fees are deducted for each of the same time intervals by selecting the previous game parameters. The player can continue to play during these time intervals using the same fee (by selecting the same game parameters), as long as the player has enough balance within the player's account to pay for the fees. More specifically Walker discloses: a method of operating a gaming system, said method comprising:

(a) receiving a wager from a player, the wager corresponding to a plurality of credits (cols. 4:6-10);

(b) indicating a balance of the credits (the balance of credits is the amount of coins inserted in the gaming machine, or the electronic credit associated to the player's account, cols. 4:6-10, 6:5-6, 14:55-65.), the balance being divisible into a plurality of

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fees, each one of the fees including at least part of one of the credits (722 in Fig. 2B, 724 in Fig. 7 discloses the type of fees. The balance is used to pay for wagering games. The balance is divisible by a plurality of wagering fees when the player has enough credits in the balance.);

(c) activating a game session for a game for an activation period, the activation period being divisible into a plurality of time intervals [Applicant's specification fails to device the terms "game session". The broadest reasonable interpretation of the terms "game session" will be used. The terms, "game session" is interpreted as the time period from when the player starts playing at a gaming machine, and ends when the player stops playing at the gaming machine. Thus, if the player plays a game session with multiple duration of intervals (722 in Fig. 2B), the game session is divisible into a plurality of time intervals. For example, when a player plays two hours straight on a gaming machine, the game session of two hours is divisible into a plurality of time intervals if the player selects the time interval for one hour as indicated in Fig. 2b of Walker.];

(d) during the activated game session:

(1) receiving a plurality of play inputs from the player (starting controller 222 in Fig. 2B):

(2) in response to each one of the play inputs (starting controller 222 in Fig. 2B):

(i) performing a play of the game (col. 4:6-26); and

(ii) providing at least one of a plurality of different outcomes based on the play, at least one of the outcomes corresponding to an award, the award having a value (col. 4:6-26, 6:56-7:21 and Fig. 6);

(3) for each one of the time intervals, deducting one of the fees from the balance [The player can select same game parameters using the same wager fee (col. 7:39-54). A player interface 264 or 238 is used to select the game parameter (col. 4:54-65).] the deduction being independent of the play inputs and the outcomes [The deduction is based on the wager selected the player interface 264 or 238 Fig. 2b, and col. 4:54-65). This deduction is separate and independent from the play input (start control 22 in Fig. 2B). Furthermore, the deduction is dependent on the duration of time (722 in Fig. 2b) and not the play inputs and the outcomes.]; and

(4) for each one of the provided outcomes which corresponds to one of the awards, adding the value of the award to the balance [The award is added to the balance, (col. 4:21-26).], the added value extending the activation period of the game session [The player can select same game parameters using the same wager fee (col. 7:39-54). Furthermore, it can be interpreted that none of the outcomes corresponds to the awards. Therefore, no value is added to the balance.];

(e) determining which one of a plurality of events occurs first, the events including:

(1) a termination input received from the player (cash out button, col. 4:34);
and

(2) the balance falling below a minimum level required for playing the game (The balance is below the fee to pay for another interval. For example, the balance is below \$100, in Fig. 2b.) ;

(f) continuing the activation of the game session until the determined event occurs (As discussed above, the player can continue to pay for another duration of interval.); and

(g) providing a payout to the player in response to the termination input being received when the balance is above zero [The remaining balance is paid out to the player (col. 4:26-34). Furthermore, it can be interpreted that player plays until the balance is zero. Thus no payout is provided since the balance is not above zero.].

Second interpretation of Walker:

As discussed above, Walker discloses the claimed invention when interpreting Walker's duration of flat rate play session (722 in Fig. 7 and 2B) as the claimed "time intervals". Another interpretation of Walker is made by interpreting Walker's duration of flat rate play session (722 in Fig. 7 and 2B) as the claimed "activated game session" wherein the amount paid for the flat rate play session (i.e. \$100 for one hour, as indicated in Fig. 2B) is the "balance". More specifically, Walker discloses a method of operating a gaming system where the player plays a flat rate play session for a flat rate price (see abstract). The player can select different flat rate play sessions based on the game parameters (col. 7:39-54). The flat rate price is interpreted as the balance, and the flat rate play session is interpreted as the "activated game session". After the wager is made, the CPU generates a random number and identifies a corresponding outcome

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(col. 4:17). Based on identified outcome, an outcome display is provided, and the appropriate payout is made (col. 4:15-26). Fig. 13 illustrates the method in which the game system provides a payout. A flat rate database (246) and a casino player database (344) tracks and audit the flat rate play session (Figs. 4-5). A termination occurs when the players cashes out (14:11-14), or the balance to flat rate play session ends. If the player terminates the game session while the balance is above zero, the remaining credit is paid out (added to player's credit balance, col. 14:11-14). Otherwise, it can be interpreted that the player plays until the balance associated with the game session is zero. It is noted that the claimed steps (d) (4) of adding the value of the balance is not required if none of the provided outcomes corresponds to the awards.

Walker significantly discloses the claimed invention but fails to specifically teach the activation period is divisible into a plurality of time intervals and for each one of the time intervals, deducting one of the fees from the balance, the deduction being independent of the play inputs and the outcomes. Nevertheless, such limitations are implied or would have been obvious to one of ordinary skilled in the art. Walker discloses the value remaining (430) is calculated and the interval remaining (516) is calculated to allow the player continue the flat rate play session (cols. 6:36-38, 12:31-60, 13:13-50), or be added to the player's credit balance (col. 14:15-22). Thus it is implied or would or would have been obvious to have fees deducted in intervals in order to calculate the value remaining and the interval remaining. Having the total value being divisible into a plurality of fees and the period of time being divisible into a plurality of time intervals will provide a specific fee or a specific time interval. This will allow the

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remaining value and the remaining time interval to be evenly calculated. Furthermore, this will allow players to play intervals of the flat rate session. Playing at intervals of the flat rate session will allow the player to play a flat rate gaming session for a smaller fee for a smaller amount of playing time. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Walker's method of playing a flat rate playing session in order to evenly calculate the remaining value and the remaining time interval, and allow a player to play a flat rate gaming session for a smaller fee for a smaller amount of playing time.

Claims 43, 52. Walker discloses for each time interval the fees deducted are equal to each other (If the player selects the same game with the same game parameters, then the wager fee will be the same. Furthermore, see rejection using an alternative interpretation for claim 42 above.).

Claims 44, 53. Walker discloses each time interval is an equal interval of time (Player can select the same game parameters including the same time interval, col. 5:22-33, Fig. 2B. Furthermore, see rejection using an alternative interpretation for claim 42 above.).

Claims 46, 55, 65. Walker discloses that the display indicates the payout (col. 4:20-22).

Claims 47, 56, 66. Walker discloses receiving a pause input during the game session; and stopping the deducting step at least temporarily in response to the pause input [A fee is required for a gaming session. After the gaming session is over, the player can momentarily stop playing by not providing the fee to start the next gaming session. Furthermore, player can stop the session momentarily (col. 13:13-17) and continue at a later time (col. 13:36-42).].

Claims 51 and 64. See rejection for claim 42 above. Furthermore, Walker discloses a gaming system comprising: at least one display device; at least one input device; at least one processor (Figs. 2A-2B); and

at least one memory device which stores a plurality of instructions (cols. 3:67-4:5), which stores a plurality of instructions, which when executed by the at least one processor.

Regarding claim 64, Walker discloses that the outcome occurs randomly using a random number generator (col. 4:10-20). Thus it is possible that all of the plurality of outcomes (or at least two outcomes, in a game session where only two games are played) randomly provide winning outcomes. The winning outcomes are associated with an award that can be used to pay for another game interval (See rejection for claim 42 above.).

Claims 60, 62. Walker discloses the balance is a time-varying balance [In the first interpretation, the balance refers to the players amount associated with the player's

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account. This balance changes according to time since the time played is based on the fee, and the fee is deducted from the balance. In the second interpretation the balance refers to the amount paid for the flat rate play session. This balance is deducted as the player continues to play within the game play session.].

Claims 61 and 63 are rejected under 35 U.S.C. 102(b) as anticipated by Walker et al. (US 6,077,163) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walker et al. (US 6,077,163) in view of Luciano et al. (US 2001/0041610).

Claims 61, 63. Walker discloses automatically extending the activation period of the game session in response to each provided outcome which corresponds to one of the awards. If none of the outcomes corresponds to one of the awards, then the activation period of the game session is not extended. Therefore Walker discloses the claimed invention. Furthermore, it is well known in the art to allocate all of the player's credit for a game session. In an analogous art to wagering games, Luciano discloses a method of allow a play to play all the credits allocated to the player (paragraph 83). When modifying Walker's flat rates to play a game session using all the credits within the balance as taught by Luciano, the player's balance will be automatically deducted to allow the player play the game session. Since the balance is automatically deducted, the game session is considered to be automatically extended according to the deducted amount. This will allow the player to play a continual game session without the interruptions of making wagers. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walker's flat rates

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and incorporate Luciano's method of using all the credits for a game session in order to allow the player play a continual game session without the interruption of making wagers.

Response to Arguments

Applicant's arguments with respect to claims 42-44, 46-47, 51-53, 55-56, 60-66 have been considered but are moot in view of the new ground(s) of rejection. A new ground of rejection has been made using Walker et al. (US 6,077,163) and Walker in view of Luciano et al. (US 2001/0041610) to address the amended limitations.

Claims rejections under 35 USC 103

Regarding the first interpretation using Walker, Applicant argues that Walker fails to teach that the deduction is not independent of the game outcomes and play inputs. More specifically, Applicant argues that Walker depends upon the play inputs by the player. Each play causes an amount of credit to be deducted from Walker's player account. However, the Walker discloses that the actual play input that allows the player to play the game (input 222 in Fig. 2b) and the user input to make wagers (264 or 238 in Fig. 2B, col. 4:54-65) are separate inputs. A player interface 264 or 238 is used to select the game parameter (col. 4:54-65). This interface is different from the play input (222). Furthermore, as discussed in the 112 first paragraph rejections above, Applicant's specification fails to disclose this limitation.

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Regarding the second interpretation using Walker, Applicant fails argues that Walker does not discloses extending the length of the player session. However, regarding claims 4, 51 and the dependent claims, limitation (d) (4) of adding the value of the balance is not required if none of the provided outcomes corresponds to the awards. Thus Walker discloses the claimed invention. Furthermore, as discussed in the 112 first paragraph rejections above, Applicant's specification fails to disclose this limitation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
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JHY